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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/826,869	04/16/2004	Ricardo Alexander Gomez	5285-0002	9828

35301 7590 07/24/2006

MCCORMICK, PAULDING & HUBER LLP  
CITY PLACE II  
185 ASYLUM STREET  
HARTFORD, CT 06103

EXAMINER
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KASZTEJNA, MATTHEW JOHN

ART UNIT	PAPER NUMBER
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3739

DATE MAILED: 07/24/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

SP

**Office Action Summary**

Application No.

10/826,869

Applicant(s)

GOMEZ, RICARDO ALEXANDER

Examiner

Matthew J. Kasztejna

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 08 May 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-15 and 42 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-15 and 42 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 16 April 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on May 8, 2006 has been entered.

In response to the amendment filed on May 8, 2006, amended claim 1 and canceled claims 16-41 are acknowledged. The objection to the drawings is *withdrawn*. The current rejections of the claims *stand*. The following reiterated grounds of rejection are set forth:

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-7, 10-15 and 41-42 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent Application Publication 2002/0022762 to Beane et al.

**In regards to claim 1**, Beane et al disclose a sterile apparatus to protect endoscopes comprising: an impact resistant housing 110 having an outer surface defining an opening, an interior of the housing defining a canal having a first end

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communicating with the opening and a second end terminating within the housing for receiving a distal lens of an endoscope (see Figs. 2a-f); a defogging material disposed adjacent to the second end of the canal for defogging a distal lens of an endoscope when inserted within the canal (see paragraph 0056); and a self-sealing mechanism 128 disposed within the canal, the self-sealing mechanism being configured to allow for an endoscope to enter the canal and make contact with the defogging material and to prevent the defogging material from spilling out of the canal (see paragraph 0053).

**In regards to claims 2 and 4**, Beane et al disclose a sterile apparatus to protect endoscopes, wherein the canal is shaped for receiving a plurality of types of endoscopes (see paragraph 002).

**In regards to claim 3**, Beane et al disclose a sterile apparatus to protect endoscopes, wherein the apparatus is made of disposable material as it is well-known that all materials regardless of composition are capable of being disposed.

**In regards to claim 5**, Beane et al disclose a sterile apparatus to protect endoscopes, wherein the apparatus is configured to protect endoscopes during intermittent use (see paragraphs 007-0016).

**In regards to claim 6**, Beane et al disclose a sterile apparatus to protect endoscopes, wherein the apparatus is inherently configured to protect endoscopes during transportation (see Fig. 2a).

**In regards to claim 7**, Beane et al disclose a sterile apparatus to protect endoscopes, wherein the interior of the housing includes: a storage sheath defining the canal, the outer surface of the housing and the storage sheath defining a cavity

therebetween; and an impact absorbing material substantially filling the cavity (see Figs. 2a-f).

**In regards to claim 10**, Beane et al disclose a sterile apparatus to protect endoscopes, wherein the impact absorbing material is a liquid (see paragraph 0057-0058).

**In regards to claim 11**, Beane et al disclose a sterile apparatus to protect endoscopes, wherein the impact absorbing material is a gas (see paragraph 0060).

**In regards to claims 12-15**, Beane et al disclose a sterile apparatus to protect endoscopes, further comprising an anchor and a cord attached to the housing and the anchor, to be used for a means for removable affixing the housing to a surface (see paragraphs 0066-0068).

**In regards to claims 41-42**, Beane et al disclose a sterile apparatus to protect endoscopes, further comprising a reservoir for communicating with the second end of the canal for accommodating the defogging material (see paragraphs 0012-0013)

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent Application Publication 2002/0022762 to Beane et al. in view of Dohm et al. (U.S. Patent No. 5,720,391).

**In regard to claim 8**, Beane et al. disclose a sterile apparatus to protect endoscopes but are silent with respect to wherein the impact absorbing material is Styrofoam. However, Dohm et al. teach a similar transportation case for a medical instrument having a spacer 212 made of shock absorbing material, such as a styrofoam material (see col. 5, lines 64-66). Dohm et al. thus demonstrate that the use of styrofoam materials for cushioning a medical device during transport are well known in the art. Accordingly, it would have been obvious for one of ordinary skill in the art at the time the invention was made to utilize Styrofoam in the apparatus of Beane et al. as an alternate means for cushioning the endoscope.

Claims 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent Application Publication 2002/0022762 to Beane et al. in view of Lantz (U.S. Patent No. 6,910,582).

**In regard to claim 9**, Beane et al. disclose a sterile apparatus to protect endoscopes but are silent with respect to wherein the impact absorbing material is a gel. However, Lantz teaches a similar transportation case having a gel pack 40 for cushioning (see col. 5, lines 55-65). Lantz thus demonstrates that the use of gel materials for cushioning is well known in the art. Accordingly, it would have been obvious for one of ordinary skill in the art at the time the invention was made to utilize a gel in the apparatus of Beane et al. as an alternate means for cushioning the endoscope.

### ***Response to Arguments***

Applicant's arguments filed May 8, 2006 have been fully considered but they are not persuasive.

Applicant states that Beane et al. does not teach or suggest a self-sealing mechanism disposed within the canal, the self-sealing mechanism and configured to allow for an endoscope to enter the canal and make contact with the defogging material and to prevent the defogging material from spilling out of the canal. However, Beane et al. disclose the device wherein the distal end 124 is attached to bottle 118, and proximal end 122 is attached to a stem 126 on housing 112. Distal end attaches to bottle 118 via complementary screw threadings 128 (inside tube 114) and 130 (on bottle 118). Alternatively, bottle 118 and distal end 124 can be attached by an interference or press fit, using, e.g., an O-ring. Proximal end 122 is similarly attached to stem 126 using, e.g., complementary screw threadings, an insert mold, or an interference fit (see paragraph 0053). The interference or press fitting is configured to allow the endoscope to enter the canal and make contact with the defogging material and further prevents spillage of the material out of the canal, thus meeting the limitations of claim 1.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew J. Kasztejna whose telephone number is (571) 272-6086. The examiner can normally be reached on Mon-Fri, 8:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Linda C.M. Dvorak can be reached on (571) 272-4764. The fax phone

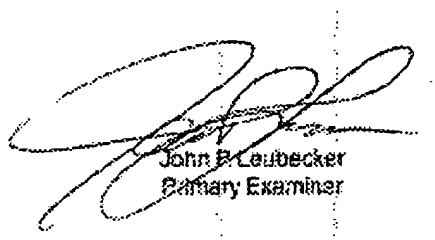
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number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

MJK *MK*

7/18/06



John B. Leubecker  
Primary Examiner